REMARKS

Claims 1-31 are present in the application and have been subjected to restriction by the Examiner under 35 U.S.C. §§121 (37 C.F.R. § 1.142) and § 372 as follows:

> Group I, claims 1-14 and 16-31, drawn to a method for obtaining plants tolerant to abiotic stress conditions by introducing into a plant cell a CDK nucleic acid molecule that results in the presence of a CDK protein that is not susceptible to inhibitory phosphorylation.
>
> Group II, claims 1-11, 13 and 15-31, drawn to a method for obtaining plants tolerant to abiotic stress conditions by introducing into a plant cell a Wee-kinase nucleic acid molecule that results in the present of a CDK protein that is not susceptible to inhibitory phosphorylation.
>
> Group III, claims 1-11, 13 and 15-31, drawn to a method for obtaining plants tolerant to abiotic stress conditions by introducing into a plant cell a MIK nucleic acid molecule that results in the presence of a CDK protein that is not susceptible to inhibitory phosphorylation.
>
> Group IV, claims 1-11, 13 and 15-31, drawn to a method for obtaining plants tolerant to abiotic stress conditions by introducing into a plant cell a MYT nucleic acid molecule that results in the presence of a CDK protein that is not susceptible to inhibitory phosphorylation.

In support of the present restriction requirement, the Examiner alleges that the subject matter defined by the claims represents four distinct inventions stating that "the inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features."

As indicated, and in order to be fully responsive to the Examiner's requirement for restriction, Applicants provisionally elect to prosecute the subject mater of Group I, claims 1-14 and 16-31, drawn to a method for obtaining plants tolerant to abiotic stress conditions by introducing into a plant cell a CDK nucleic acid molecule that results in the presence of a

CDK protein that is not susceptible to inhibitory phosphorylation, and reserve the right to file one or more divisional applications directed to the non-elected subject matter in this application.

Pursuant to 37 C.F. R. § 1.111 and § 1.143, Applicants hereby traverse the Examiner's requirement for restriction for the following reasons.

An Examiner's authority to require restriction is defined and limited by statute:

> If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions.

35 U.S.C. 121, first sentence (emphasis added).

The rules which the PTO follows in implementing unity of invention considerations in PCT applications are found in 37 C.F.R. § §1.475-1.477, 1.499, and MPEP §18903.03(d). Whether an application is at the international or national stage, PCT Rule 13 governs governs a unity of invention analysis.

When making a lack of unity of invention requirement, the Examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group i.e., why there is no single general inventive concept specifically describing the unique special technical feature in each group.

Under PCT Rule 13, a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression "technical feature" is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art.

According to the Examiner, the technical feature linking the inventions of Groups I-IV appears to be the introduction into a plant cell of a nucleic acid molecule that results in the presence of a CDK protein that is not susceptible to inhibitory phosphorylation. It is the Examiner's position however, that the introduction into a plant cell of a nucleic acid molecule that results in the presence of a CDK protein that is not susceptible to inhibitory phosphorylation is obvious or anticipated over Hemerly et al., (1995) *EMBO J.* 14(16):3925-3936. Thus, according to the Examiner, the introduction into a plant cell of a nucleic acid molecule that results in the presence of a CDK protein that is not susceptible to inhibitory phosphorylation does not constitute a special technical feature as defined by PCT Rule 13.2 because allegedly it does not define a contribution over the prior art. The Examiner has further alleged that the methods of Groups I-IV employ structurally and functionally distinct nucleic acids encoding structurally and functionally distinct polypeptides.

Notwithstanding the Examiner's characterization of the present invention, Applicants respectfully submit that there is one single general inventive concept which specifically describes the unique special technical feature of each of Groups I-IV. This singe, general inventive concept involves the finding that plants which are tolerant to abiotic stress conditions may be obtained by introducing into a plant cell, plant tissue, or plant, a nucleic acid molecule or regulatory sequence which introduction results in the presence of a Cyclin Dependent Kinase (CDK) protein that is not susceptible to inhibitory phosphorylation under abiotic stress conditions.

The Examiner's assertion that Hemerly et al. 1995, renders obvious Applicants' introduction into a plant cell of a nucleic acid molecule that results in the presence of a CDK protein that is not susceptible to inhibitory phosphorylation, is respectfully submitted to be in error for the following reasons:

First, Hemerly et al. do not teach or suggest a method of obtaining plants tolerant to abiotic stress conditions by introducing a nucleic acid molecule which results in the presence of a CDK protein that is not susceptible to inhibitory phosphorylation under abiotic stress conditions. Although Hemerly et al. did transform plants with a mutant form of cdc2a where T14 and Y15 were replaced with A14 and F15, the reference does not teach or suggest the present invention as claimed in Claims 1-31. Thus, Applicants assert that there is a technical relationship among Groups I-IV, and that the restriction requirement is improper and should be withdrawn.

The courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the Applicant has done herein. The CCPA has observed:

> We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on

Trade and Tariffs (GATT), Applicants are required to conduct simultaneous prosecution, as here, requiring excessive filing costs or a compromise of the term of their patent assets.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. § 121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that § 121 protects a patentee from an allegation of same-invention double patenting, *Studiengesellschaft Kohle mbH v. Northern Petrochemical Co.*, 784 F.2d 351, 355, 228, U.S.P.Q. 837, 840 (Fed. Cir. 1986). *In Gerber Garment Technology Inc. v. Lectra Systems Inc.*, 916 F.2d 683, 16 U.S.P.Q. 2d 436 (Fed. Cir. 1990), the Federal Circuit held that § 121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee's rights and to serve the public's interest in the legitimacy of issued patents, applicant respectfully urges the Examiner not to require restriction in cases such as the present application wherein various aspects of a unitary invention are claimed.

Hence, it is again respectfully urged that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims.

Respectfully submitted,

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